

REMARKS

I. STATUS OF THE CLAIMS

Without prejudice or disclaimer, claims 11-13 and 17 have been cancelled, and claims 1 and 15 have been amended herein. Support for those amendments can be found in the claims and specification both as originally filed. There is no issue of written description or new matter.

Claims 1-9, 14, 15, and 18-34 are pending and subject to examination upon entrance of this paper.

II. REJECTION UNDER 35 U.S.C. § 112

A. First Paragraph

Claims 1-9, 11-15, and 17-34 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly "failing to comply with the written description requirement." Office Action at 2-7. Specifically, the Office alleges that the instant application fails to provide a sufficient description of a representative number of species of cyclic carbonate falling within the scope of the genus formula I. The Office also contends that "the cyclic carbonates described in claim 13, criteria V, include compounds that are also described in the references, which according to applicants do not or are not capable of polymerizing with external stimulus." Office Action at page 6. The Office further asserts that the instant example does not provide information regarding what the external stimulus is and whether the composition increase the hair volume or strength or resilience, and what is the effect that can be achieved in treating nails as opposed to hair. See *id* at 6-7. Applicants respectfully disagree.

The test for determining compliance with the written description requirement of 35 U.S.C. § 112, first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the presently claimed subject matter. *See* M.P.E.P. 2163. Determining whether the written description requirement is satisfied requires reading the disclosure in light of the knowledge possessed by those skilled in the art. *See id.* That knowledge can be established, for example, by reference to patents and publications available to the public prior to the filing date of the application. *See, e.g., In re Alton*, 76 F.3d 1168, 37 U.S.P.Q.2d 1578 (Fed. Cir. 1996).

Here, as noted by the Office, the specification as filed discloses that compounds of the genus formula I can be those described in the documents as listed at page 7 of the specification as filed. The specification further indicates that those documents provide procedures of preparing the cyclic carbonates. Accordingly, Applicants submit that the disclosure of the application as originally filed reasonably conveys to those of ordinary skill in the art that the inventors had possession of the presently claimed subject matter at that time.

In contrast to the Office's position regarding claim 13, which has been cancelled herein but limitations thereof have been incorporated into claim 1, Applicants assert that the compounds of criteria V in claim 13, which is current claim 1 as amended, are not described in references listed in paragraph [011] at page 2 of the specification as filed. For example, EP 1 022 014 describes the use of ethylene and propylene carbonate, *see* Table 2 and 3 at pages 8-9; U.S. 4,746,322 describes the use of ethylene and propylene carbonate, and 1,2-propylene glycol carbonate, *see* Examples 12 and 13,

and line 16, col. 8; U.S. 4,402,985 describes the use of 4-isopropyl-5,5-dimethyl-m-dioxan-2-one, the structure of which is shown at lines 10-15, col.1; DE 198 51 451 describes the use of cyclic carbonate prepared by using diols include ethylene glycol, 1,2-pentanediol, 1,2-hexanediol, 1,2-octandiol, 1,2-decanediol, 1,2-dodecane and 1,2-hexadecanediol, see lines 35-45 at page 5. However, none of those carbonate falls within the scope of criteria V of claim 13, now claim 1 as amended. Therefore, Applicants respectfully request a clarification as to which reference describes the compounds of criteria V in claim 13, now claim 1 as amended.

Contrary to the Office's allegation that the instant application does not provide information as to what the external stimulus is, see Office Action at page 6, line 6 from bottom, the specification at paragraph [0190] describes that heat was used as the external stimulus for the example.

For the foregoing reasons, Applicants respectfully request that the rejection be withdrawn.

B. Second Paragraph

Claims 1-4, 11-15 and 17-34 are rejected under 35 U.S.C. § 112, second paragraph as allegedly "being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." Office Action at 7. Specifically, the Examiner alleges that it is unclear what the nails and skin are being treated for with the instant composition.

Solely to expedite prosecution, Applicants have amended the claims to focus on embodiments directed to hair and eyelashes. The instant application provides an

example comprising, inter alia, applying to hair a composition comprising a cyclic carbonate.

Claim 15 and claims depending therefrom are directed to compositions, rendering the Office's rejection moot. Accordingly, this rejection should be withdrawn.

III. REJECTIONS UNDER 35 U.S.C. § 103

A. Claims 1-9, 11-15, 17-23, 27, and 31-34 are rejected under 35 U.S.C. § 103(a) as allegedly "being unpatentable over" Macromolecular Rapid Commun. 1997 by Toshikazu Takata (Takata) in view of WO 99/43667 (WO 99) or WO 98/47995 (WO 98), and further in view of US 5,362,486 to Nandagiri et al (Nandagiri) for the reasons set forth at pages 7-10 of the Office Action. Applicants respectively disagree and traverse.

Applicants respectfully point out that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art." MPEP 2143.01(III) (emphasis in original) (citing *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (S. Ct. 2007)). Takata describes a variety of cyclic carbonate undergoes volume expansion on polymerization. Takata, however, does not teach or suggest using those cyclic carbonate for cosmetic products, let alone for treatment of hair or eyelashes as currently claimed, as amended.

The Office relies on WO 98 and WO 99 for the teaching of certain compounds in cosmetic use. WO 98 describes orthocarbonates useful for delivery of sustained perfume or fragrance to fabric. See Abstract. However, those orthocarbonates differ from the cyclic carbonates taught by Takata and are not within the scope of the currently amended claims. See page 3 of WO 98. WO 99 describes cyclic pro-

perfumes suitable for delivery of enhanced fragrance longevity to human skin. Similar to WO 98, those cyclic pro-perfumes differ from the cyclic carbonates taught by Takata and are not within the scope of the currently amended claims. See page 3 of WO 99. Accordingly, neither WO 99 nor WO 98 rectifies Takata's deficiency.

Nandagiri teaches that it is known to polymerize monomers, in-situ, while in contact with hair. See col. 2, lines 51-55. However, Nandagiri also indicates the results are **highly unpredictable and inconsistent**. See col. 2, lines 59-68. For example, the monomers can be unsuitable for cosmetic compositions because they are irritating or harmful to hairs and or skins. Further, the polymer hair treatment may lack durability, usually washing out after one or two shampoos. See *id.* Nandagiri, as a whole, thus does not provide any guidance as to which monomers can be used for hair treatment. As such, the combined teachings of Nandagiri and the other three references would not have suggested a reasonable level of success. That lacking of predictability renders the currently amended claims non-obvious over the combination of the references.

Applicants thus respectfully request the rejection be withdrawn.

B. Claims 1-9, 11-15, and 17-34 are rejected under 35 U.S.C. § 103(a) as allegedly "being unpatentable over" US 6,156,077 to Shibata et al (Shibata) and Takata in view of Nandagiri.

The Office relies on Shibata for the teaching of a hair composition comprising an oxyalkylenated xanthan gum, a film forming polymer, a reducing agent and an oxidation dye. As noted by the Office, Shibata fails to teach the instant cyclic carbonates. Shibata thus does not cure the deficiencies of Takata and Nandagiri discussed above, e.g., lacking of predictability regarding the use of cyclic carbonates in cosmetic

compositions for the treatment of hair and eyelashes. Accordingly, this rejection should be withdrawn.

IV. CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and timely allowance of the pending claims.

If the Examiner believes a telephone conference could be useful in resolving any of the outstanding issues, she is respectfully invited to contact Applicants' undersigned counsel at (650) 849-6649.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 30, 2010

By: Wen Li
Wen Li, Ph.D.
Reg. No. 62,185